

Notice of Allowability

Application No.

10/528,904

Examiner

Erica E. Cadugan

Applicant(s)

HANSSON ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to dk. no. ERI0017.US filed 9/23/05 and interview of 9/27/06.
2. ☒ The allowed claim(s) is/are 12-22.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 3/18/05
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20060921.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Todd Taylor on September 27, 2006.

The application has been amended as follows:

The following paragraph has been added on page 1 of the specification, between the title "An assembly for removing chips from a cutting work area of a cutting tool" and the heading "Technical Field":

The present application claims priority under 35 USC 365 to U.S. provisional applications 60/319579, filed September 27, 2002, now abandoned, and 60/414408, filed September 30, 2002, now abandoned.

Claim 12 (Currently Amended). An assembly for removing chips from a cutting tool working area on a workpiece, said assembly comprising:

an axially expandable and collapsible tubular member for at least partially enclosing the cutting tool working area and including a first end and a second end;

a support structure for supporting said first end of said axially expandable and collapsible tubular member;

a cross-piece for supporting said second end of said axially expandable and collapsible tubular member;

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at least one biasing spring being configured and arranged for resiliently biasing said support structure and said cross-piece away from one another;

a housing having a chips-receiving chamber located adjacent one of said first end and said second end for engagement with the working area of the workpiece, said chips-receiving chamber including an outlet being configured to be connected to a vacuum source for removing a plurality of chips from said chamber; and

a hub portion located at an other of said first end and said second end, said hub portion being configured for engagement with a cutting machine.

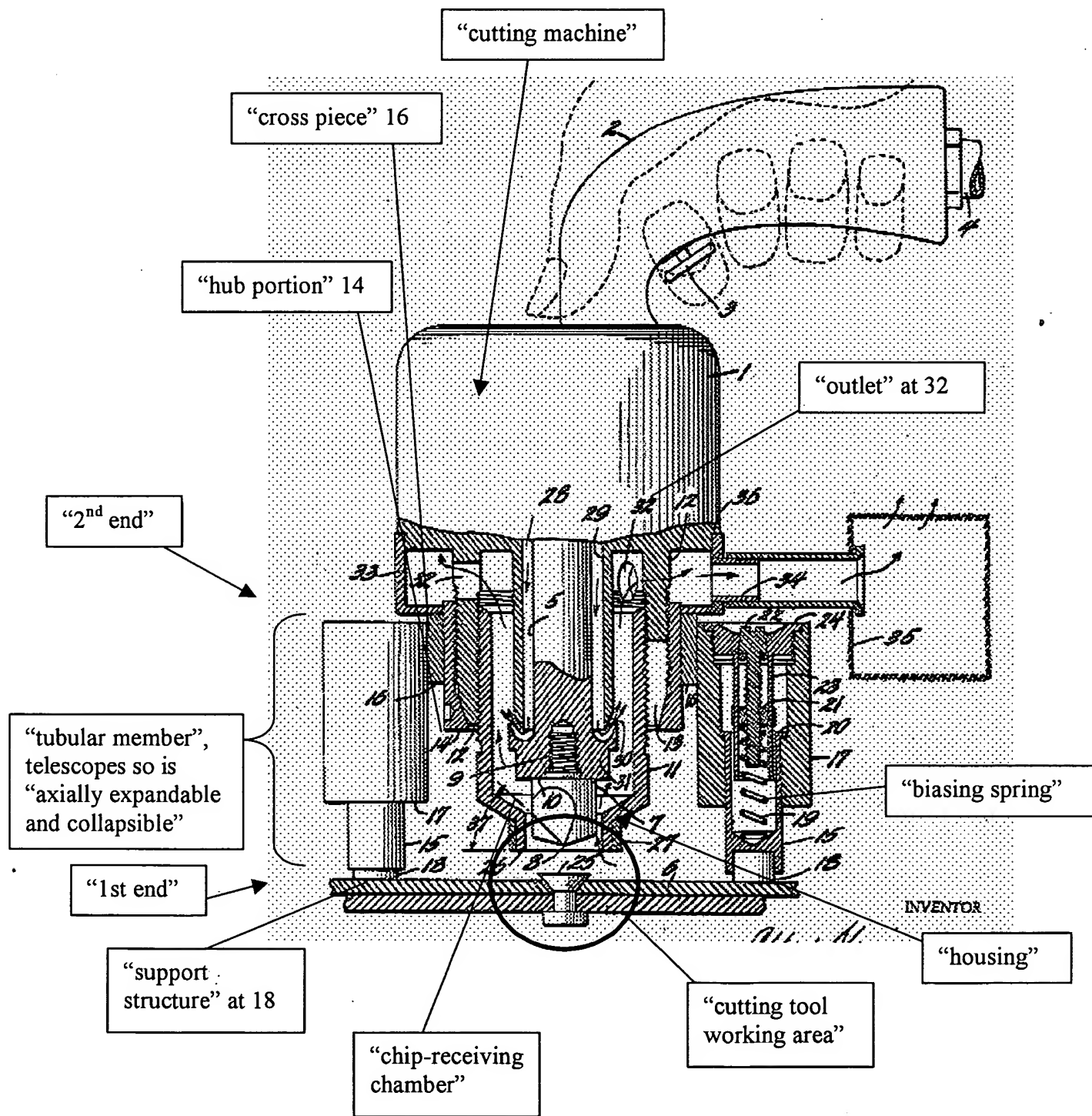
Claim 19 (Currently Amended). The assembly of claim 18, wherein said support structure includes a U-shaped bracket with a plurality of side legs interconnected by said hub portion, each of said plurality of side [leg] legs provided with a section for fixation of said support structure to a non-rotating component of the cutting machine.

2. The following is an examiner's statement of reasons for allowance:

There are a number of devices for removing chips from a cutting tool working area on a workpiece in the prior art. However, there is no prior art of record that teaches such a device having the entire combination of elements that are set forth in independent claim 12. To illustrate, Examiner will describe in detail a representative piece of prior art.

Below is a reproduction of the figure from U.S. Pat. No. 2,527,968 to Sherman et al., with corresponding parts labeled.

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Firstly, Sherman does not explicitly teach that the “outlet” is connected to a vacuum source, but it is considered to be “configured to be connected to a vacuum source”, noting that at the area labeled 34, the cylindrical connection there would appear be a shape to which a vacuum hose could be affixed.

However, even assuming *arguendo* that the “outlet” is considered to be so configured, Sherman still does not teach all the limitations of claim 12, noting that the axially expandable and collapsible tubular member labeled above is not positioned or located such that it is able to be used “for at least partially enclosing the cutting tool working area” as set forth in independent claim 12, nor is there any way to so modify the teachings of Sherman without precluding Sherman’s device from functioning in the way it was intended to function. Note that if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See also MPEP section 2143.01.

Note also that if the member 11 (labeled “housing” above) was considered the claimed “tubular member” that at least partially encloses the cutting tool working area, Sherman would still not anticipate present claim 12. Firstly, even assuming *arguendo* that the member 11 could be considered to be “axially expandable and collapsible” by virtue of its capability to move axially up and down via its screw threaded connection with portion 12 shown in the figure, that would make one of elements 27 and 14 the “support structure for supporting said first end of said axially expandable and collapsible tubular member” and the other one of elements 27 and 14 the “cross-piece for supporting said second end of said axially expandable and collapsible tubular member”. There would be no “housing having a chips-receiving chamber located adjacent one

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of said first end and said second end for engagement with the working area of the workpiece, said chips-receiving chamber including an outlet being configured to a vacuum source for removing a plurality of chips from said chamber” (noting that element 11 was already considered for the sake of argument the “tubular member” having the first and second ends), nor is there any prior art of record that would reasonably and absent impermissible hindsight motivate one having ordinary skill in the art to so modify the teachings of Sherman.

Thus, for at least the foregoing reasoning, Sherman neither anticipates nor renders obvious the present invention as set forth in independent claim 12.

The aforescribed prior art being a representative example of the closest prior art of record, the prior art of record neither anticipates nor renders obvious the present invention as set forth in independent claim 12.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Priority

Comment on priority:

3. Firstly, it is noted that the above amendment to the first sentence of the specification takes care of any outstanding issues with making the priority or benefit claim properly (domestic priority). It is also noted that no petition to the Office to accept an unintentionally delayed benefit claim (in order for the first sentence of the specification to be able to be amended as set forth above so as to set forth a proper benefit claim) is necessary, noting that even though there

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was no proper (emphasis added on the “proper”) benefit claim made at the time the application was filed nor within the time limits set for doing so, the Office *did* recognize a benefit claim at the time of filing, and thus, no petition to the Office to accept an unintentionally delayed claim is necessary (see, for example, MPEP section 201.11). Also, it is further noted that while not recommended, benefit claims under 35 USC 120 (and correspondingly 35 USC 365 which refers back to 35 USC 120) to prior provisional applications are not precluded (see MPEP section 201.11), and thus the above benefit claim to the prior provisional applications under 35 USC 365 is not improper. (Note that priority to prior provisional applications is normally claimed under 35 USC 119(e), see MPEP sections 1893.03(c) and 201.11).

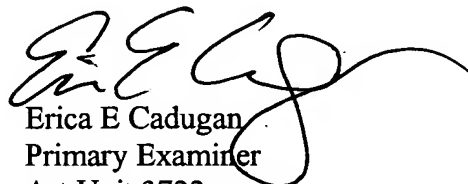
Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 6:30 a.m. to 4:00 p.m., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Erica E Cadugan
Primary Examiner
Art Unit 3722

eec
September 27, 2006

Approved
EEC
9/27/06

